

THERMAL CONTROL OF FLOWRATE IN ENGINE COOLANT SYSTEM

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**PETITION**

for the acceptance of an unintentionally-delayed claim for priority, or for filing a request for the restoration of the right of priority

[001] The PTO examiners in this present case have instructed the applicant to petition for the acceptance of an unintentionally-delayed claim for priority, in order for our priority claim to be accepted. **The examiners have indicated that this patent application will go abandoned if we fail to make this Petition.**

However, the applicants feel the examiners have made a mistake in instructing the applicants to file the Petition. Our position is that our PCT priority claim has already been properly established, as evidence by the attached Exhibits.

[002] By contrast, the examiners' opposing position is that we have failed to properly establish our priority claim. This alleged failure is the basis for the examiners' instruction to us to file this Petition for Acceptance of Delayed Priority Claim.

[003] If it turns out that this Petition is indeed not needed, as we suggest, we would request that the amount of the **Petition Fee be refunded.**

On the other hand, conditional upon the examiners being correct that this Petition is indeed required, then **the applicants do wish to proceed with this Petition.**

[004] The above-identified patent application US-10/505,343 is derived from international patent application PCT/CA-2003/002017. The PCT application claims priority from US-10/330,108.

The key dates in respect of the US national stage patent application are:

- PCT National Stage Entry Date in USA: 23 August 2004
- PCT International Filing Date: 30 December 2003 = PCT/CA-2003/002017
- PCT Priority Date: 30 December 2002 = US.Pat.Apl.No: 10/330,108

[005] Copies of the some of the PCT Application and the PCT National Stage Entry documents are attached. These are:

(Upon filing the PCT application):

- Ex.1. Sheet 4 of the as-filed PCT REQUEST form, which shows the entry in Box No VI PRIORITY CLAIM. The REQUEST form was one of the PCT application documents filed at the Canadian Patent Office on 30 December 2003.
- Ex.2. the Certificate from the US PTO re US.Pat.Apl.No: 10/330,108, filed 30 dec 2002.
- Ex.3. the PCT Notification of Date of Receipt of Priority Document.
- Ex.4. the PCT Notification Concerning Submission or Transmittal of Priority Document.

(Upon Entry into National Stage):

- Ex.5. the Application Data Sheet accompanying the Entry documents (two pages).

In addition to the above, we also attach a copy of our proposed amendment to the first sentence(s) of the specification, which we submitted to the PTO in October 2008.

[006] Rule 1.78(a) contains the provisions regarding claiming priority in a PCT-derived case.

The relevant parts are:

Rule 1.78(a)(2)(i): an . . . international application designating United states of America claiming the benefit of one or more prior-filed copending nonprovisional applications . . . must contain or be amended to contain a reference to such prior-filed application, identifying it by application number (consisting of the series code and serial number) . . .

Clearly, that reference was indeed made, in this case, in the PCT application documents.  
See Exhibit 1.

Rule 1.78(a)(2)(ii): This reference must be submitted during the pendency of the later-filed application. If the later-filed application is a non-provisional application which entered the national stage from an international application after compliance with 35.U.S.C.371, this reference must also be submitted within the later of four months from the date on which the national stage commenced . . . or sixteen months from the filing date of the prior-filed application. These time periods are not extendable.

Clearly, the reference was made in the PCT application within the 16-month time-limit.  
See Exhibits 2,3,4.

Rule 1.78(a)(2)(iii): If the later-filed application is a non-provisional application, the reference required by this paragraph must be included in an application data sheet (§1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

The reference was not placed in the specification upon Entry into the Natl.Stage in USA. However, the reference was included in the application data sheet, which was filed upon Entry into the National Stage. See Exhibit 5.

[007] In our international application PCT/CA-2003/002017, the PCT application papers as submitted to the Receiving Office (the RO being the Canadian Patent Office) contained the reference required (by 35.U.S.C.120) to our own earlier US patent application, US-10/330,108.

This reference was placed in the "Priority Box" of the PCT Request form, Ex.1. The CA PO established that our priority claim was timely and proper, as shown by Exs.2,3,4. The whole PCT procedure, with its many priority-date-dependent functions, has proceeded in the usual way. Thus, we cannot see how our compliance with Rules 1.78(a)(2)(i) and (ii) might possibly be even slightly open to doubt.

[008] Rule 1.78(a)(2)(iii) requires us, upon Entry, to insert the reference actually into the specification, or into the data sheet that accompanies Entry. (The rule clearly expresses this requirement on an "either/or", not a "both/and", basis.) It is true that we did not insert the reference actually into the specification. However, Exhibit 5 is a copy of the as-filed Entry Data Sheet, on which our reference to our earlier US application is clearly set down.

Thus, in addition to our having complied with the requirements of (a)(2)(i), within the time limits of (a)(2)(ii), clearly we have also complied with the requirements as expressed in 1.78(a)(2)(iii).

[009] The only thing we have not done is that we did not insert the reference to our earlier US application actually into the specification of the present patent application.

On the other hand, Rule 1.78(a)(2)(iii) makes it clear that such insertion is optional. As we read Rule 1.78(a)(2)(iii), so long as the reference to the earlier US application is made on the Entry Data Sheet, there is no need for the reference to be placed actually in the specification.

[0010] Furthermore, even if it were to be decided that there *is* a requirement under (a)(2)(iii) for the reference to be placed actually in the specification, we do not believe the time-limit expressed in

(a)(2)(ii) applies to such requirement.

As we read the whole rule, the time limit provisions of 1.78(a)(2)(ii) only apply to our making the priority claim in our PCT application. The time-limit provisions expressed in Rule 1.78(a)(2)(ii) do not apply to inserting the reference actually into the specification as mentioned in (a)(2)(iii).

[0011] In fact, in October 2008, we did submit to the PTO a request for an insertion to be made between the title and the first sentence of the specification, which included the reference to our earlier US patent application. If that amendment has not yet been entered, we request that it be entered. Attached is a further copy of the request for amendment to the specification, which we originally submitted in October 2008.

[0012] We believe our position is clearly correct, simply from a perusal of Rule 1.78. However, the examiners in the instant patent application (given that they have instructed us to file this Petition) evidently reached a different conclusion.

We state our position again, that we feel we have already done everything we are required to do to establish our priority claim, under Rule 1.78. In our view, we do not now need to file this Petition, and we do not now need to insert an amendment into our specification, in order to comply with anything in Rule 1.78.

[0013] We now consider the situation that arises if, contrary to the above-expressed views, it is decided, in this Petition, that our priority claim is indeed faulty -- as is contended by the examiners -- and that, in order now to remedy that fault, we are indeed required to Petition to insert into the specification the reference as mentioned in Rule 1.78(a)(2)(iii) -- as is contended by the examiners.

[0014] Rule 1.78(a)(3) states that: If the reference required by 35.U.S.C. 120 and paragraph (a)(2) of this section is presented after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35.U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed co-pending non-provisional application . . . may be accepted if the reference identifying the prior-filed application by application number . . . was unintentionally delayed. A petition to accept an unintentionally-delayed claim under 35.U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35.U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) the surcharge set forth in § 1.17(t); and
- (iii) a statement that the entire delay . . . was unintentional.

[0015] Under 1.78(a)(3)(i), the proposed amendment to the specification has already been submitted to the PTO in October 2008. Attached is a copy of what was submitted. If that amendment has not yet been entered, we request that it now be entered.

Under 1.78(a)(3)(ii), the surcharge set forth in §1.17(t) is submitted herewith.

Under 1.78(a)(3)(iii), we state that the entire delay, between the date the claim was due under paragraph 1.78(a)(2)(ii) and the date the claim was filed, was unintentional.

Submitted by:

/Anthony Asquith/

Anthony Asquith  
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Attached:

- Exhibits 1-5 (6 sheets)
- Amendments to Disclosure (copy) (1 page)

Please charge the amount of the fee required by this paper to our deposit account, number 01-2555. Please credit any overpayment or refund to our deposit account, number 01-2555.